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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,460	06/05/2001	Dan Kikinis	007287.00036	6281
22907 7590 06/23/2008 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051				
EXAMINER				
SALCE, JASON P				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/875,460

Applicant(s)

KIKINIS, DAN

Examiner

Jason P. Salce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-11, 13-16, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-11, 13-16, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 5/14/2008 have been fully considered but they are not persuasive.

Applicant argues that the '208 Ellis reference fails to teach a video display on a remote device. The examiner disagrees and clearly notes Paragraph 0110 and Figure 5 which teaches that the remote program guide access device 24 contains a display.

Applicant also argues that the Ellis reference fail to teach EPG selections. The examiner disagrees and notes Paragraph 0111 of the Ellis '208 reference which clearly teaches using the remote program guide access device 24 to provide EPG selections. Further note Paragraphs 0115-0125 for storing EPG selections in order to remind or record a future broadcasted program, store parental control EPG selections for restricting programs to view and storing favorite EPG channel selections, therefore teaching that EPG selections are clearly stored. The examiner also notes that although the Ellis '208 patent fails to teach that the device 24 is not a cellular phone, the '926 Ellis patent teaches using a cellular phone to make EPG selections.

In regards to claims 25-26, Applicant argues that the '208 Ellis patent fails to teach an indication of which buttons are appropriate for the EPG. The examiner disagrees and notes that Figure 9 clearly teaches an OK button, therefore teaching that an OK button must be pressed to acknowledge the reminder notification displayed. Clearly the OK button represents an indication of which buttons are appropriate for the EPG. The same analysis applies to Figures 7-8 and 10.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 6-7, 9-11, 14-15 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. Patent Publication Application No. 2005/0028208) in view of Ellis et al. (U.S. Patent No. 6,774,926).

Referring to claim 1, Ellis discloses receiving EPG selection entered over the Internet via a remote device having a first video display (**see Paragraphs 0014-0016 and 0092**), wherein the EPG includes preset selections (**see Paragraph 0024**).

Ellis also discloses displaying the EPG on the first video display of the remote device (**see Paragraph 0097**).

Ellis also discloses receiving selections entered over the Internet via the remote device (**see Paragraphs 0097-0100**).

Ellis also discloses storing the EPG selections on a storage device (**see Paragraph 0072 for the remote program guide access device storing the EPG data**).

Ellis also discloses transmitting the EPG selections to be displayed on a second video display associated with a television when requested (**see Paragraph 0016 for making program selections remotely, which will be displayed on the TV**).

Ellis is silent as to the EPG selection being entered via a web-enabled cellular phone.

Ellis (**'926 Patent**) discloses a cellular phone 42 with display 100, wherein the display 100 is used to display and select EPG items (**see Column 7, Lines 18-26 and Column 8, Lines 60-67**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to combine the systems of Ellis and Ellis (**'926 Patent**) in order to provide a system capable of utilizing a mobile phone having EPG capability as a remote controller, thereby providing the user with extended functionality and control and allowing the user to reserve programs from remote locations. Also note that Ellis (**'926 Patent**) specifically states that an advantage to the system allows the cell phone to access the schedule information and perform various functions, such as searching for programming of interest, establishing favorite programs, setting reminders and setting parental controls (**see Column 1, Lines 40-46 of the '926 Ellis Patent**).

Referring to claims 2 and 3, Ellis discloses storing EPG selections on a broadcast server and set top box (see Paragraph 0017 and Figure 2).

Referring to claim 6, Ellis further discloses that the system displays EPOG selection on the remote terminal when requested (see Paragraph 0015).

Referring to claim 7, in light of the combined disclosures used to rejection claim 6, claim 7 would be an obvious variant. Transmitting EPG data to multiple remote terminals is obvious in light of the disclosure of Ellis already teaching transmittal to one remote terminal.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the teaching of Ellis in order to provide multiple separate devices, thereby allowing multiple users to utilize the system concurrently.

Referring to claims 9-11 and 14-15, see the rejection of claims 1-3 and 6-7, respectively. In regards to claim 9, further note that Ellis discloses that the EPG can also be displayed on the second video display associated with the television (**see Paragraph 0071**).

Referring to claims 25-26, the Ellis Publication discloses that the EPG includes an indication of which buttons are appropriate for the EPG (**see Figures 7-10**).

3. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. Patent Publication Application No. 2005/0028208) in view of Ellis et al. (U.S. Patent No. 6,774,926) in further view of Terakado et al. (U.S. Patent No. 6,246,441).

Referring to claim 8, Ellis and Ellis ('926 Patent) disclose all of the limitations of claim 6, but are silent as to transmitting one or more programs to be separately displayed concurrently with displaying the EPG selections.

Terakado discloses (in the same field of endeavor) a similar system which is capable of allowing a user to view a program broadcast on the television while concurrently viewing the EPG data on the remote terminal (see Column 9, Lines 47-53).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the systems of Ellis, using the teachings of Terakado in order to provide a system capable of allowing a user to watch a broadcast program on the television receiver 9, while checking programs to be broadcast from a time onward by using an EPG without obstructing the display of the television receiver 9 (see Column 9, Lines 50-53 of Terakado).

Referring to claim 16, see the rejection of claim 8.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason P Salce/
Primary Examiner, Art Unit 2623

Jason P Salce
Primary Examiner
Art Unit 2623

June 18, 2008